

PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Thomas Gritzmacher
Serial No. : 10/005,771
Filing Date : November 8, 2001
For : Billing System and Method for Network
Group Art Unit : 3693
Examiner : Sara M. Chandler
Attorney Docket No. : NG(MS)7266

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Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This Reply Brief is in response to the Examiner's Answer dated September 17, 2008. This Reply Brief addresses the Examiner's Answer concerning the appealed claims 1, 3-6, 8, 9, 11-16, 18-28 and 36.

I. Appealed Claims 1, 16 and 36

On pages 7-8 of the Appeal Brief, Appellant's representative set forth reasons that U.S. Patent Publication No. 2002/0176647 to Jones ("Jones") fails to teach or suggest storing, at a client system, information related to a time-based bill when a network interface is activated and when the network interface is deactivated, and transmitting a call detail record from a client system to a billing module on a billing system (or to a billing system, as recited in claim 36) based on the information related to the time based bill, as recited in claims 1, 16 and 36. In response, the Examiner states the following:

In some examples, packet billing system 104 generates a call detail record for the call transmitted over [the] packet system 106 based on the start records and the end record. (Jones, [0037]) Examiner's Answer, Page 17.

Note: The records in Jones have to be stored at least temporarily because although a start record is obtained at the time of activation, the end record occurs later at the time of deactivation. The call detail record cannot be generated until all the records (i.e., start/end) are stored. Examiner's Answer, Page 17.

This is interpreted as being equivalent to the fourth limitation of claim 1... Examiner's Answer, Page 17.

[i]t is uncertain whether the features of the communication device 112 and the packet billing system 104 have to be made integral in Jones in order to arrive at the "client system" of the invention as claimed. In Jones the communication device 112 and the packet billing system 104 are both part of the Packet communication system 101 which could arguably be interpreted as the "client system" (See Fig. 1, [Par.] [0032]). Examiner's Answer, Pages 18-19.

Appellant's representative respectfully disagrees with the Examiner's contentions. Claims 1 and 36 recite determining when a network interface is activated at a client system when a client link between a network and the client system is established. Similarly, claim 16 recites determining when a network interface to a content provider is activated and deactivated. Additionally, claims 1, 16 and 36 each recite the client system stores information related to a time based bill based on when the network interface is activated and when the network interface is deactivated. Thus, when claims 1, 16 and 36 are read as a whole, it is clear that the client system for which activation and deactivation times of a network interface are determined is the same client system at which information related to a time base bill is stored. Conversely, nothing in Jones would teach or suggest that the same entity (e.g., packet billing system 104) that stores information relating to a time based bill ever determines an activation time and deactivation time for a network interface at that same entity. Instead, in Jones, the packet billing system 104 detects a call setup from a separate entity (the communication device 112; See Jones Par. [0035]). Thus, Appellant's representative respectfully submits that even given its broadest reasonable interpretation, the packet communication system 101 disclosed in Jones does not read on the client system recited in claim 1.

On pages 8-10 of the Appeal Brief, Appellant's representative set forth reasons that it would not have been obvious to modify the teachings of Jones to make the subject matter recited in claims 1, 16 and 36. In response, the Examiner stated the following:

It has been held that merely making something integral only requires routine skill in the art. *In re Larson*, 340 F.2d 965, 968, 144 U.S.P.Q. 347, 349 (CCPA 1965). Examiner's Answer, Page 18.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Jones to provide wherein all components of the client system were integrated (i.e. communication device and packet billing system). One would have been motivated by increased efficiency and cost reductions associated with integrating components. Examiner's Answer, Page 18.

Appellant's representative respectfully disagrees with both, (1) the Examiner's interpretation of the modification to Jones that would result in the subject matter recited in claims 1, 16 and 36, as well as (2) the reasoning for the modification provided by the Examiner. In particular, the Examiner appears to contend that by virtue of the ruling in *Larson*, it would have been obvious to one of ordinary skill in the art to modify Jones such that the communication device 112 and the packet billing system 104 were an integrated unit. Appellant's representative respectfully submits that such a modification would not be supported by the holding in *Larson*.

In *Larson*, the Court of Customs and Patent Appeals held that it would have been a matter of obvious engineering design choice to employ one piece of construction material (namely a brake drum integral with clamping means) in place of a multi-part brake disc and clamp that are rigidly secured together. 340 F.2d 965, 968, 144 U.S.P.Q. 347, 349. Thus, in *Larson*, it was held that it would have been obvious to make a single unit out of two entities that were already acting as a single unit via a mechanical coupling. Conversely, the modification the Examiner is proposing would require that two separate units (the communication device 112 and the packet billing system 104) that are not operating as a single unit to be integrated. Furthermore, if the packet billing system 104 of Jones were modified as the Examiner suggests, the packet billing system 104 would no longer interface with the public switched telephone network billing system 194 over a link 186, thereby fundamentally modifying the functionality of the packet billing system 104 (See e.g., Jones, FIG. 1, Par.

[0032]). Thus, Appellant's representative respectfully submits that combining the packet billing system 104 and a communication device 112, as suggested by the Examiner, would not be a mere engineering design choice, as was the case in *Larson*.

Moreover, as shown in Figure 1 of Jones, the packet billing system 104 services multiple communication devices 112 and 113 (See Jones, Par. [0032]). Additionally, if the packet billing system 104 were integrated into the communication devices, as suggested by the Examiner, then each communication device would require its own packet billing system. Thus, Appellant's representative respectfully submits that the Examiner's proposed modification of Jones does not simply "make something integral" as contended, but instead, would require replacing a single entity (packet billing system 104) with multiple entities (packet billing systems at each of the communication devices).

Further, Appellant's representative respectfully submits that rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 127 S. Ct. 1727, 1741 (U.S. 2007). citing *In re Kahn*, 441 F.3d 997, 998 (CA Fed. 2006). As stated above, in the Examiner's Answer, the Examiner states that one of ordinary skill would have been motivated to modify Jones to increase efficiency and reduce cost associated with integrating the packet billing system 104 and the communication device 112.

Appellant's representative respectfully submits that the Examiner's reasoning is not rational. Rational is defined in the Random House dictionary ©2006 in one way as "agreeable to reason; reasonable; sensible." The Supreme Court's requirement for a rational underpinning to support a legal conclusion of obviousness must therefore be sensible to the person of ordinary skill in the art.

On the flip side, a conclusion that is not rational is most likely the result of the improper use of hindsight. The Examiner has offered no evidence as to how the suggested modification to Jones would increase efficiency and/or reduce costs. Appellant's representative respectfully submits that replacing a single system (the packet billing system 104) with multiple systems (integrating the packet billing system 104 into each of the communication devices 112 and 113) would not typically reduce costs or increase efficiency.

Appellant's representative respectfully submits that modifying Jones in the manner suggested by the Examiner would increase the complexity and cost of the system by requiring each of the communication devices to include not only the software and/or hardware for the packet billing system, but also hardware and/or software to interface with the public switched telephone network billing system 194. Additionally, in the modified system, each communication device 112 would presumably need additional security measures to prevent unauthorized access to the integrated packet billing system 104, further increasing the complexity and cost of the system. Thus, Appellant's representative respectfully submits that the Examiner's reasoning for modifying the teachings of Jones is not rational, and appears to be based solely on the employment of impermissible hindsight.

For the reasons stated above, as well as those already stated in the Appeal Brief, Appellant's representative respectfully submits that claims 1, 16 and 36 are patentable. Thus, withdrawal of the rejection of claims 1, 16 and 36 is respectfully requested.

II. Appealed Claims 15 and 27

On page 10 of the Appeal Brief, Appellant's representative set forth reasons that Jones does not teach or suggest displaying call detail record information base on information relating to a time based bill, as recited in claims 15 and 27. In response, the Examiner stated the following:

"[d]isplaying call detail record information based on information relating to a time-based bill" is also predictable in light of the teachings of Jones above. In other words, the purposes of Jones is to bill for usage and the call detail records are used to aid this objective. It is predictable that a display of the call dtail records would be made available (i.e., particularly to the users that are the cause of the bill being generated and from whom payment is expected). Examiner's Answer, Page 19.

Appellant's representative respectfully submits that the above statement by the Examiner illustrates the differences between Jones and the claims 15 and 27. In Jones, all billing information is stored at the public switched telephone network billing system 194 which generates a bill based on information received from the packet billing system 104 (See Jones, Par. [0037]). There is no teaching or suggestion in Jones that the generated bill is ever displayed. Accordingly, for the reasons stated above, as well as the reasons given in the Appeal Brief, Appellant's representative respectfully requests withdrawal of the rejection of claims 15 and 27.

CONCLUSION

In view of the foregoing remarks, Appellant's representative respectfully submits that the present application is in condition for allowance. Appellant's representative respectfully requests reconsideration of this application and that the application be passed to issue.

No additional fees should be due for this Reply Brief. In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to Deposit Account No. 08-2025.

Respectfully submitted,

/Christopher P. Harris/
Christopher P. Harris
Reg. No. 43,660

TAROLLI, SUNDHEIM, COVELL
& TUMMINO, L.L.P.
1300 East Ninth Street, Suite 1700
Cleveland, Ohio 44114
(216) 621-2234
(216) 621-4072 (Facsimile)
Customer No.: 26294